

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TELTRONICS, INC.

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Appeal No. 96-3118  
Control No. 90/003,492<sup>1</sup>

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ON BRIEF

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Before McCANDLISH, Senior Administrative Patent Judge, and  
FRANKFORT and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Teltronics, Inc., the assignee of U.S. Patent No. 4,609,579

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<sup>1</sup> Request, filed July 8, 1994, for the reexamination of  
U.S. Patent No. 4,609,579, issued to Gary G. Hills on September 2, 1986, based on Application 07/750,890, filed July 1, 1985.

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(the Hills patent), appeals from the final rejection (Paper No. 20) of claims 1 through 16, all of the claims pending in this reexamination proceeding.

#### RELATED LITIGATION

The record indicates that the Hills patent "was first litigated in an action for infringement against Southwestern Bell Company, CA No. A 91 CA 728, wherein a jury found the patent not invalid and infringed. On appeal the verdict was upheld in the United States Court of Appeals for the Federal Circuit, No. 93-1356" (Reexamination Request, Paper No. 1, page 2).

The record also indicates that the Hills patent was, at least as of April 3, 1997, the subject of litigation (apparently stayed), styled Teltronics, Inc. v. Minnesota Mining and Manufacturing Company, Civil Action No. 94 CA 128SS, in the United States District Court for the Western District of Texas,

Austin Division (see the status request filed on April 3, 1997, Paper No. 37, page 1).

#### THE INVENTION

The invention relates to a "self-adherent, stretchable, resilient pressure wrapping tape and method of application for compressingly protecting a wire splice or the like, the tape having a gauge incorporated therein for indicating the amount of stretch of the tape" (Hills patent, Abstract). Claims 1, 11 and 12, the three independent claims on appeal, are illustrative and read as follows:<sup>2</sup>

1. A wrap for compressing a wire or the like, comprising:

an elongated, thin, tape adapted for wrapping around the wire, the tape being longitudinally stretchable and resilient to impart a compressive force to the wire when the tape is stretchingly wrapped around the wire; and

gauge means comprising an impression printed on the tape for indicating the amount of longitudinal stretch of the tape, the gauge means presenting a generally distorted visual appearance in the unstretched condition and a generally undistorted visual appearance when stretched a desired longitudinal amount.<sup>3</sup>

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<sup>2</sup> The various references in dependent claims 7 through 10 to the "first" and "second" impression appearances lack a proper antecedent basis. Based on the underlying disclosure, we understand that these references should be to the "distorted" and "undistorted" impression appearances, respectively, which are set forth in parent claim 1.

<sup>3</sup> In a Certificate of Correction dated November 4, 1986, claim 1 was amended to rectify a printing error.

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11. In a stretchable, resilient, self-adherent tape which applies a compressive force when stretchingly wrapped around a wire or the like, the improvement comprising:

an elongation indicator printed on the tape which presents a first, generally distorted appearance when the tape is unstretched and presents a second, generally undistorted appearance when the tape is stretched a certain amount to yield [the] a desired compressive force.

12. A method for protecting a wire, wire splice, or the like, comprising the steps of:

providing a stretchable, resilient tape having gauge means printed thereon for indicating the amount of stretch of the tape;

coupling a segment of the tape to the wire;

stretching another segment of the tape until said gauge means presents a generally undistorted, legible appearance indicating a certain amount of stretch; and

wrapping the stretched, other segment circumferentially around the wire, the stretched segment applying a compression to the wire.

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THE EVIDENCE

The items relied upon by the examiner as evidence of anticipation and obviousness are:

|   |           |               |
|---|-----------|---------------|
| Bijou <sup>4</sup>                                    | 3,613,679 | Oct. 19, 1971 |
| Shimirak <sup>5</sup>                                 | 4,466,843 | Aug. 21, 1984 |
| Takahata et al.                                       | 52-40381  | Mar. 29, 1977 |
| Japanese Patent Document (Japanese '381) <sup>6</sup> |           |               |
| Ogata et al.  | 54-6880   | Mar. 31, 1979 |
| Japanese Patent Document (Japanese '880) <sup>7</sup> |           |               |

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<sup>4</sup> A copy is attached to the appellant's main brief as Appendix F.

<sup>5</sup> A copy is attached to the appellant's main brief as Appendix D.

<sup>6</sup> The record contains three different English language translations of this reference. One is attached to the appellant's main brief as Appendix B, one was recently prepared by the U.S. Patent and Trademark Office, and one was prepared for the appellant's counsel by Adams Translations. For the purpose of discussing the reference in this decision, we shall refer to the Adams translation since it is superior to the other two in terms of idiomatic and grammatical form. Copies of the Adams and the U.S. Patent and Trademark Office translations are appended to this decision for the sake of completeness and convenience.

<sup>7</sup> A copy of an English language translation is attached to the appellant's main brief as Appendix C.

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TELTRONICS, INC.'S RESPONSE TO SOUTHWESTERN BELL TELEPHONE  
COMPANY'S FIRST REQUEST FOR ADMISSIONS<sup>8</sup>

An additional item relied upon below pursuant to 37 CFR  
§ 1.196(b) as evidence of obviousness is:  
  
The Deposition of Gary Hills, dated May 11, 1994, given In The  
Matter Of: TELTRONICS, INC., A TX CORP. vs. MINNESOTA MINING AND  
MANUFACTURING CO., A MN CORP.<sup>9</sup>

The items relied upon by the appellant as evidence of  
patentability are:

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<sup>8</sup> A copy is attached to the appellant's main brief as part of Appendix K. The record indicates that this item was generated in the "action for infringement against Southwestern Bell Telephone Company, CA No. A 91 CA 728" (Reexamination Request, Paper No. 1, page 2; also see page 5 in the request). An admission relating to prior art is a fact which is part of the scope and content of the prior art which every examiner is required to consider whether in an initial examination or in a reexamination proceeding. Ex parte McGaughey, 6 USPQ2d 1334, 1338 (Bd. Pat. App. & Int. 1988).

<sup>9</sup> A copy is attached to the appellant's main brief as part of Appendix K. As indicated in note 8, supra, an admission relating to prior art is a fact which is part of the scope and content of the prior art which every examiner is required to consider whether in an initial examination or in a reexamination proceeding. Id. at 1338.

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The 37 CFR § 1.132 Declaration of Gary G. Hills filed on April 11, 1995 and entered into the record as Paper No. 17 (the Hills Objective Evidence Declaration)<sup>10</sup>

The 37 CFR § 1.132 Declaration of Gary G. Hills filed on April 11, 1995 and entered into the record as part of Paper No. 19 (the Hills Technical Declaration)<sup>11</sup>

The 37 CFR § 1.132 Declaration of Dick Wagner filed on October 13, 1995 and entered into the record as part of Paper No. 24 (the Wagner declaration)<sup>12</sup>

The 37 CFR § 1.132 Declaration of Gary G. Hills filed on April 15, 1996 and entered into the record as part of Paper No. 30 (the supplemental Hills Objective Evidence Declaration)<sup>13</sup>

#### THE APPEALED REJECTIONS

Claims 1 through 16 stand rejected by the examiner as follows:

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<sup>10</sup> A copy is attached to the appellant's main brief as Appendix G.

<sup>11</sup> A copy is attached to the appellant's main brief as Appendix J.

<sup>12</sup> A copy is attached to the appellant's main brief as Appendix I.

<sup>13</sup> This declaration was submitted with and is attached to the appellant's reply brief.

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a) claims 1 through 4, 6 through 8 and 10 through 16 under 35 U.S.C. § 102(b) as being anticipated by the Japanese '381 reference;

b) claims 1 through 4, 6 through 8 and 10 through 16 under 35 U.S.C. § 102(b) as being anticipated by the Japanese '880 reference;

c) claim 5 under 35 U.S.C. § 103 as being unpatentable over the Japanese '381 reference in view of TELTRONICS, INC.'S RESPONSE TO SOUTHWESTERN BELL TELEPHONE COMPANY'S FIRST REQUEST FOR ADMISSIONS;

d) claim 9 under 35 U.S.C. § 103 as being unpatentable over the Japanese '381 reference in view of Bijou; and

e) claims 1 through 16 under 35 U.S.C. § 103 as being unpatentable over Shimirak in view of the Japanese '381 reference and Bijou.<sup>14</sup>

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<sup>14</sup> In the final rejection, the examiner also relied on the Raychem XAGA 1600 publication which is of record to support this particular rejection. Upon reconsideration, however, the examiner has withdrawn his reliance on this reference (see page 3 in the main answer).

Reference is made to the appellant's main and reply briefs (Paper Nos. 28 and 30) and to the examiner's main and reply answers (Paper Nos. 29 and 31) for the respective positions of the appellant and the examiner with regard to the propriety of these rejections.<sup>15</sup>

#### DISCUSSION

In rejecting a claim, an examiner bears the initial burden of presenting a factual basis establishing a prima facie case of unpatentability. See In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1444-45 (Fed. Cir. 1990); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If this burden is met, the burden of coming forward with a showing of facts supporting the opposite conclusion shifts to the applicant. After such rebuttal evidence is submitted, all of the evidence must be considered anew, with patentability being determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument. Of course, if

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<sup>15</sup> In a paper (Paper No. 32) filed in response to the examiner's reply answer, the appellant submits that "the 'Examiner's Reply Answer' was improperly filed and is not authorized under Manual of Patent Examining Procedure §1208.04." This section of the Manual of Patent Examining Procedure (6th ed., Rev. 2, July 1996), however, lends no support to the appellant's position. Accordingly, we have considered the reply answer in reviewing the merits of this appeal.

the examiner's initial showing does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. Id.

I. THE ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102(b)

It is noted that the appellant has not challenged the standing 35 U.S.C. § 102(b) rejections of dependent claims 2, 3, 6 through 8, 10 and 13 through 16 with any reasonable specificity. Therefore, these claims shall stand or fall with the independent claims from which they respectively depend (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)). This leaves for our consideration the merits of the standing 35 U.S.C. § 102(b) rejections of independent claims 1, 11 and 12, and of claim 4 which depends from claim 1. For each of the two § 102(b) rejections, we shall discuss these claims in the order they are argued in the main brief.

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed, 468 U.S. 1228 (1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984). Under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). As the court

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stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326  
(CCPA 1981)(quoting Hansgirt v. Kemmer, 102 F.2d 212, 214,  
40 USPQ 665, 667 (CCPA 1939)):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Turning now to the first of the standing 35 U.S.C. § 102(b)  
rejections, the Japanese '381 reference discloses

tapes that are required to be wound around their objects in a standardized manner, at a certain stretch quantity and a specified tension, as you see in the formation of an insulating layer for an insulated wire or cable, the insulation formation at the cable core connection portion in a cable junction box, the formation of water-proof layer, the formation of a semiconductive layer in preparing electrostatic shielding, and other cases. In most of the practical cases, the work of this type is performed as on-the-

spot manual winding, and, therefore, requires a high degree of skill to obtain a satisfactory result [Adams translation, page 3].

These tapes may be made of various base materials including rubber (see page 3 in the Adams translation). In order to facilitate the manual winding at a specified tension and stretch quantity, the tapes are provided with means for visually indicating when the desired tension and stretch quantity have been attained. As described in the reference,

the visual tension measuring system based on the present invention comprises an arrangement in which certain shapes, patterns (characters and symbols) and the like are continually shown on the tape in the direction of the tape in such a way that the shape or pattern is compressed and distorted so that it can represent their targeted normal appearance when the tape has stretched to a prescribed quantity, so the degree of closeness of the distorted shape, pattern or the like to the target [expected] standard appearance can be used as the norm of the visual determination of tension [Adams translation, page 4].

By way of example, the tapes may be printed with vertically elongated rectangles, vertically elongated ellipses, or vertically elongated triangles which assume the appearance of squares, circles and equilateral triangles, respectively, when

the tapes are stretched and tensioned the prescribed amount (see the drawing figures).

The appellant contends that the tape recited in independent claim 11 is not anticipated by the Japanese '381 reference because this reference fails to meet three of the limitations recited in this claim, to wit: those requiring the tape (1) to be "resilient," (2) to be "self-adherent," and (3) to have an elongation indicator which presents a second, generally undistorted appearance when the tape is stretched a certain amount "to yield a desired compressive force" (see pages 18 through 20 and 23 through 26 in the main brief and pages 1 through 5 in the reply brief).

The first and third of these alleged differences are related and shall be discussed together.

As indicated above, the tape disclosed by the Japanese '381 reference is designed to be wound around objects in a standardized manner at a certain stretch quantity and at a specified tension. The tape, which may be made of a rubber base material, includes an elongation indicator which presents a first, generally distorted appearance when the tape is unstretched and a second, generally undistorted or normal appearance when the desired stretch quantity and specified

tension are achieved.

One of ordinary skill in the art would readily appreciate that such a tape necessarily is "resilient" in the sense used by the appellant. In this regard, the appellant's specification defines resiliency "as meaning the tendency to resume its original shape when stretched" (Hills patent, column 1, lines 46 and 47). Words which are defined in the specification must be given the same meaning when used in a claim. McGill, Inc. v. John Zink Co., 736 F.2d 666, 674, 221 USPQ 944, 949 (Fed. Cir.), cert. denied, 469 U.S. 1037 (1984). In the context of a tape which is applied at a certain stretch quantity and at a specified tension, one of ordinary skill in the art would understand that the specified tension inherently results from the tendency of the stretched tape to resume its original shape.

One of ordinary skill in the art also would readily appreciate the teaching in the Japanese '381 reference that the tape is applied at a certain stretch quantity and a specified tension to necessarily mean that the tape is stretched a certain amount to yield a desired compressive force. The direct relationship between the tension in a stretchable resilient element and the compressive force yielded thereby is a well known phenomenon in the prior art and is embodied, for example, by the

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conventional rubber band. This well known relationship is reflected by the acknowledgment in the appellant's specification that the "amount of compression developed by the pressure tape is a function of many factors, but of critical importance is the amount of elongation or stretch imparted to the tape during wrapping" (Hills patent, column 2, lines 1 through 4). In this light, one of ordinary skill in the art would recognize that when the elongation indicator on the tape disclosed by the Japanese '381 reference presents a second, generally undistorted appearance corresponding to a specified, and therefore intended, stretch amount and tension, it signifies a corresponding desired compressive force.

Thus, the Japanese '381 reference meets, under principles of inherency, the limitations in claim 11 requiring the tape to be "resilient" and to have an elongation indicator which presents a second, generally undistorted appearance when the tape is stretched a certain amount "to yield a desired compressive force." This reference does not meet, however, the limitation in claim 11 requiring the tape to be "self-adherent." In short, there is nothing in the Japanese '381 reference which indicates that the tape disclosed therein has this property. The examiner's contention that "[t]he material of the tape disclosed in reference 52-40381 is [self-]adherent because the tapes are held in place after wrapping" (main answer, page 5) is not persuasive since the tape might be held in place after wrapping by any number of means other than self-adherency.

Since the Japanese '381 reference does not disclose each and every element of the subject matter recited in claim 11, it does not establish a prima facie case of anticipation with respect to such subject matter.

The Japanese '381 reference does disclose, however, each and every element of the subject matter recited in independent claims 1 and 12.

The appellant's position to the contrary rests on the contention that the Japanese '381 reference does not meet the limitations in these claims requiring a gauge means which presents a generally undistorted appearance when the tape is stretched a desired or certain amount. According to the appellant, these limitations should be interpreted in light of the specification as calling for a gauge means which presents a generally undistorted appearance when the tape is stretched a desired or certain amount to yield a desired compressive force (see pages 21 through 26 in the main brief).

Claims 1 and 12, however, do not contain any limitation that requires the printed gauge means recited therein to present a generally undistorted appearance when the tape is stretched so as to apply a desired compressive force. Although the appellant's patent specification states that "[t]he [undistorted] appearance 34 [of printed impressions 24] is formulated such that it is achieved when the desired amount of stretch is attained corresponding to the amount of compressive force desired" (Hills patent, column 3, lines 62 through 65), this limitation cannot

properly be read into claims 1 and 12 as proposed by the appellant. It is well settled that in reexamination proceedings claims are given their broadest reasonable interpretation consistent with the specification without reading limitations from the specification into the claims. In re Paulsen, 30 F.3d 1475, 1479-80, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). All that the claim limitations in question require is that the gauge means present a generally undistorted appearance when the tape is stretched a desired or certain amount. This interpretation is entirely consistent with the underlying specification and is met by the stretch-indicating elements disclosed in the Japanese '381 reference.

Moreover, even if the claim limitations in question were to be interpreted as reciting a gauge means which presents a generally undistorted appearance when the tape is stretched a desired or certain amount to yield a desired compressive force as urged by the appellant, it would still be met by the Japanese '381 reference for the reasons discussed above in connection with claim 11.

Although not expressly argued by the appellant with respect to claims 1 and 12, the Japanese '381 reference also meets, for the reasons discussed above in connection with claim 11, the

limitations in claims 1 and 12 requiring the tape to be  
"resilient."

The Japanese '381 reference therefore establishes a prima facie case of anticipation with respect to the subject matter recited in claims 1 and 12.

On the other hand, the Japanese '381 reference fails to establish a prima facie case of anticipation with respect to the subject matter recited in dependent claim 4. As explained above, one of ordinary skill in the art would readily appreciate the tape disclosed by the Japanese '381 reference to be inherently resilient. Nonetheless, this reference is devoid of any disclosure which teaches that "the tape retains a portion of its resilient properties for substantial periods of time when stretched to around twice its unstretched elongation" as is recited in claim 4.

As for the second of the standing 35 U.S.C. § 102(b) rejections, the Japanese '880 reference relates to

[t]ape which is used while being stretched by tension applied to the tape, where figures are colored on the surface of the aforementioned tape, so that the correct elongation percentage is easily recognized by simply observing the deformation of the shape of the aforementioned figures by the stretching of the tape. For instance, tapes that are stretched by tension in use are widely used for insulation [sic, insulating] the terminal parts or connection parts of electrical wires. A point which needs particular care when such

tapes are used is that the tape should be stretched to the predetermined elongation percentage. That is, tapes such as mentioned above are usually composed of the core material of, for example, polyethylene sheet, with an adhesive layer. If such a tape is stretched in use to an elongation percentage which is too small, the adhesion at the overlapping part of the tape will not be good, thus gaps may occur. On the other hand, if it is stretched in use to an elongation percentage which is too large, cracks may be generated on the tape due to residual stress. In this manner, various types of problems occur unless the elongation percentage is correct [translation, pages 2 and 3].

By way of example, the tapes may be printed with transversely oriented rectangles or ellipses which assume the appearance of squares and circles, respectively, when the tapes are stretched the predetermined amount, and the appearance of longitudinally oriented rectangles or ellipses, respectively, if the tapes are stretched more than the predetermined amount (see Figures 1 through 3).

As was the case with the 35 U.S.C. § 102(b) rejection based on the Japanese '381 reference, the appellant contends that the tape recited in independent claim 11 is not anticipated by the Japanese '880 reference because this reference fails to meet the limitations in the claim requiring the tape (1) to be "resilient," (2) to be "self-adherent," and (3) to have an elongation indicator which presents a second, generally undistorted appearance when the tape is stretched a certain

amount "to yield a desired compressive force" (see pages 18 through 20 and 23 through 26 in the main brief and pages 1 through 5 in the reply brief).

As indicated above, the tape disclosed by the Japanese '880 reference consists of a polyethylene sheet having an adhesive layer thereon, and is designed to insulate electrical terminals or joints while being stretched by tension. The tape includes figures colored on its surface so that the correct elongation percentage is easily recognized by observing the change in the shape of the figures caused by the stretching of the tape. If the amount of stretching is too small, the adhesion at the overlapping parts of the applied tape will be poor and may result in gapping.

Here again, one of ordinary skill in the art would readily appreciate such a tape to be necessarily "resilient" in the sense used by the appellant, i.e., as having a tendency to resume its original shape when stretched. The disclosure in the reference that the adhesion at overlapping parts of the applied polyethylene tape will be poor and that gapping may occur if the tape is not sufficiently stretched clearly supports this conclusion. One of ordinary skill in the art would appreciate that the only reasonable explanation for this cause and effect

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between adequate stretching and good adhesion is that the tape is resilient and yields an adhesion-improving compressive force corresponding to the amount of stretching under tension.

For the same reasons, one of ordinary skill in the art also would readily appreciate the tape disclosed by the Japanese '880 reference to yield a desired compressive force when stretched the intended amount. Here again, reference is made to the well known physical attributes of the conventional rubber band. One of ordinary skill in the art would recognize that when the elongation indicator on the tape disclosed by the Japanese '880 reference presents a second, generally undistorted appearance (e.g., a square or circle) corresponding to the intended stretch amount, it signifies a corresponding desired compressive force.

The Japanese '880 reference also meets the limitation in claim 11 requiring the tape to be "self-adherent." Because the tape disclosed in the reference includes a layer of adhesive, the tape itself is "self-adherent" as called for by the claim.

The appellant argues that the "self-adherent" limitation in claim 11 should be interpreted in light of the underlying specification as requiring a tape material which is capable of adhering to itself without a separate adhesive (see pages 19 and 20 in the main brief and pages 4 and 5 in the reply brief). This argument is not persuasive, however, since claim 11 does not contain any limitation that requires the tape to comprise such a material. Although the appellant's patent specification states

that the tape described therein is preferably made from a plasticized polyvinyl chloride material which is self-adherent (see column 3, lines 29 through 32, in the Hills patent), this limitation cannot properly be read into claim 11 as proposed by the appellant. As noted above, it is well settled that in reexamination proceedings claims are given their broadest reasonable interpretation consistent with the specification without reading limitations from the specification into the claims. Paulsen, 30 F.3d at 1479-1480, 31 USPQ2d at 1674. All that the claim limitation in question calls for is a tape that is self-adherent. This limitation is met by the polyethylene/adhesive tape disclosed by the Japanese '880 reference.

Thus, the Japanese '880 reference meets the argued limitations in claim 11 requiring the tape to be "resilient," to be "self-adherent," and to have an elongation indicator which presents a second, generally undistorted appearance when the tape is stretched a certain amount "to yield a desired compressive force." For similar reasons, the Japanese '880 reference also meets the limitations in claims 1 and 12 requiring the tape to be "resilient" and to have a gauge means which presents a generally undistorted appearance when the tape is stretched a certain or

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desired amount. The Japanese '880 reference therefore establishes a prima facie case of anticipation with respect to the subject matter recited in claims 1, 11 and 12.

The Japanese '880 reference does not establish a prima facie case of anticipation with respect to the subject matter recited in dependent claim 4. As explained above, one of ordinary skill in the art would readily appreciate the tape disclosed by the Japanese '880 reference to be inherently resilient. Nonetheless, this reference is devoid of any disclosure which teaches that "the tape retains a portion of its resilient properties for substantial periods of time when stretched to around twice its unstretched elongation" as is recited in claim 4.

Turning now to the appellant's evidence of patentability, the teachings of the Japanese '381 and '880 references must be considered anew along with such evidence to determine the ultimate question of anticipation with regard to those claims for which the references respectively establish a prima facie case of anticipation. See Oetiker, 977 F.2d at 1446, 24 USPQ2d at 1444-45; Piasecki, 745 F.2d at 1472, 223 USPQ at 788.

For the most part, the appellant's evidence pertains to issues of obviousness, and thus is not relevant to the question of anticipation (see In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982)). The Hills Technical Declaration appears to be the only portion of such evidence which is pertinent to the issues of anticipation present in this appeal. The appellant argues that this declaration establishes that "the compression applied by a tape as it is wrapped around an object is not simply a function of the stretch in the tape but is also a function of the width of the tape, the tape cross-section, and the material properties of the tape" (main brief, page 25). Be this as it may, it does not belie our determination that one of ordinary skill in the art would recognize the elongation indicators or gauge means on the tapes respectively disclosed by the Japanese '381 and '880 references to present a second,

generally undistorted appearance when the tape is stretched a certain amount to yield a desired compressive force. Moreover, such showing is not commensurate with the actual scope of claims 1 and 12 which, as discussed above, do not require the gauge means recited therein to present an undistorted appearance when the tape is stretched a certain amount to yield a desired compressive force. Thus, the Hills Technical Declaration is entitled to little probative value as to the issues of anticipation presented in this appeal, and is clearly outweighed by the examiner's reference evidence of anticipation.

In light of the foregoing, and based on all of the relevant evidence and argument of record, we shall sustain the standing 35 U.S.C. § 102(b) rejection of claims 1 and 12, and of claims 2, 3, 6 through 8, 10 and 13 through 16 which stand or fall therewith, as being anticipated by the Japanese '381 reference. We shall also sustain the standing 35 U.S.C. § 102(b) rejection of claims 1, 11 and 12, and of claims 2, 3, 6 through 8, 10 and 13 through 16 which stand or fall with claims 1 and 12, as being anticipated by the Japanese '880 reference. We shall not sustain, however, the standing 35 U.S.C. § 102(b) rejection of claims 4 and 11 as being anticipated by the Japanese '381 reference, or the standing 35 U.S.C. § 102(b) rejection of claim

4 as being anticipated by the Japanese '880 reference.

## II. THE OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103

As recently stated by our reviewing court in In re Huang,  
100 F.3d 135, 138, 40 USPQ2d 1685, 1687-88 (Fed. Cir. 1996):

A claimed invention is unpatentable if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103 (1994). The ultimate determination as to whether or not an invention is obvious is a legal conclusion based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Within this framework, the test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). A conclusion of obviousness may be based on the common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). In this regard, skill is to be presumed on the part of the artisan. In re Sovish, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985).

There is no dispute in the present case that the second of

the foregoing factual inquiries, i.e., the level of ordinary skill in the art, is demonstrated by the prior art cited by the examiner and the objective evidence advanced by the appellant (see page 27 in the main brief). Thus, the following discussion on the obviousness issues presented in this appeal will focus on the three remaining factual inquiries to the extent that such have been argued by the appellant.

With regard to the standing 35 U.S.C. § 103 rejection of claim 5 as being unpatentable over the Japanese '381 reference in view of TELTRONICS, INC.'S RESPONSE TO SOUTHWESTERN BELL TELEPHONE COMPANY'S FIRST REQUEST FOR ADMISSIONS, claim 5 further defines the tape recited in parent claim 1 as retaining "at least around 150 psi tensile strength when stretched to twice its unstretched elongation." The Japanese '381 reference does not teach that the tape disclosed therein has this specific characteristic.

TELTRONICS, INC.'S RESPONSE TO SOUTHWESTERN BELL TELEPHONE COMPANY'S FIRST REQUEST FOR ADMISSIONS, particularly admissions 1 through 3, relates to

clear and self adherent tape made of a plasticized polyvinyl chloride material having a tensile strength and resiliency such that the tape could be stretched at least 100% while retaining a large part of its resiliency and tensile strength, as referred to in column 1, lines 35 through 47 of the [Hills] '579

patent.

The appellant admits that such tape was not invented by Hills, was in public use in the United States before the invention by Hills of the subject matter set out in the claims of the Hills patent, and was known by others in the United States before the invention by Hills of the subject matter set out in the claims of the Hills patent. Lines 35 through 47 in column 1 of the Hills patent indicate that such tape was used as a pressure-wrapped wire splice protector.

According to the examiner,

[i]t would have been obvious to one of ordinary skill in the art to have optimized the teaching of JP 52-40381 [the Japanese '381 reference] in order to develop a wrap wherein the tape retains at least around 150 psi tensile strength when stretched to around twice its unstretched elongation in view of applicant's admission [main answer, page 11].

The appellant, on the other hand, contends that the Japanese '381 reference does not disclose a gauge means as required by claim 5 via its dependence from claim 1, and that there is no suggestion or motivation in the prior art to combine such a gauge means with a tape having the properties specified in claim 5, even if the admitted prior art tape has such properties (see pages 30 and 31 in the main brief).

For the reasons discussed above in connection with the first

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35 U.S.C. § 102(b) rejection, the Japanese '381 reference does disclose a wire wrap tape having a gauge means as recited in parent claim 1. Moreover, the appellant's admissions indicate that the tensile strength retention property of wire wrap tape is an art recognized result effective variable, and that it is advantageous for such a tape to retain a large part of its tensile strength when stretched at least 100%. In this light, the prior art would have provided the artisan with ample suggestion or motivation to make the wire wrap tape disclosed by the Japanese '381 reference such that it retains a large part of its tensile strength when stretched to twice its unstretched elongation, i.e, when stretched 100%. As for the "150 psi tensile strength" retention figure specified in claim 5, the discovery of an optimum value of a result effective variable is ordinarily within the skill of the art. See In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980).

Thus, the combined teachings of the Japanese '381 reference and the admissions embodied in TELTRONICS, INC.'S RESPONSE TO SOUTHWESTERN BELL TELEPHONE COMPANY'S FIRST REQUEST FOR ADMISSIONS establish a prima facie case of obviousness with respect to the subject matter recited in claim 5.

With regard to the standing 35 U.S.C. § 103 rejection of

claim 9 as being unpatentable over the Japanese '381 reference in view of Bijou, the examiner considers that it would have been obvious in view of the combined teachings of these references to provide the tape disclosed by the Japanese '381 reference with a gauge means impression having the appearances specified in claim 9 (see pages 11 and 12 in the main answer). The appellant argues only that Bijou is non-analogous art (see pages 34 through 36 in the main brief and pages 6 and 7 in the reply brief).

In an obviousness determination under 35 U.S.C. § 103, art which is non-analogous is too remote to be treated as relevant prior art. In re Clay, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). There are two criteria for determining whether art is analogous: (1) whether the art is from the field of the inventor's endeavor, regardless of the problem addressed; and (2) if the reference is not within the field of the inventor's endeavor, whether the reference is reasonably pertinent to the particular problem which the inventor was involved. Id.

The Bijou reference relates to the field of elastic surgical bandage wraps. As stated therein,

[a] selected figure or combination of figures or other indicia is imprinted or otherwise applied to the surface of the bandage at intervals throughout the length of the bandage, or woven or otherwise incorporated into the fabric of the bandage. The figure or figures may be of a geometric form, such as a

rectangle, square, circle or ellipse. Or they may be of a conventionalized form, such as a star. Or of an abstract or decorative form such as a flower. Or they may be lines or dots or a combination of these. The figures may appear in a single line along the center of the bandage, or they may appear in two or more rows, one near each side, in which case they are more readily visible when the bandage is wrapped in successive turns in overlapped relation. It will be understood that regardless of the shape or form of the individual figures or the manner in which they are placed along the course of the bandage, the resulting pattern will be related to the elastic properties of the bandage in such a way that it will provide visual indication of varying amounts of tension. This constitutes a point-of-reference whereby the user may maintain the same tension throughout the wrapping process, or may adjust the tension to suit [Bijou patent, column 1, lines 12 through 33].

The bandage embodiment illustrated in Figures 1 and 2 contains a single row of crosswise rectangles which becomes a single row of squares when the bandage is stretched for wrapping. Bijou teaches that "[a]t this point a predetermined amount of force is required to stretch the bandage to this extent, and this corresponds to the tension existing in the bandage. The pressure applied by the bandage will be proportional to such tension" (Bijou patent, column 2, lines 8 through 12).

Bijou arguably falls outside Hills' field of endeavor, i.e., "stretchable, resilient pressure wrapping tape and method of application" (Hills patent, column 1, lines 7 and 8) for protecting a wire or wire splice. This reference, however, is

clearly reasonably pertinent to the particular problem which Hills was involved, to wit: applying a stretchable, resilient pressure wrapping tape with the correct amount of stretch so as to generate a desired amount of compression (see the "Description of the Prior Art" section in columns 1 and 2 of the Hills patent). The appellant's contention that the Hills Objective Evidence Declaration, specifically the portion thereof dealing with the invention disclosure of William Humphries (attached to the declaration as Exhibit F), compels a contrary conclusion (see pages 35 and 36 in the main brief) is not persuasive. To begin with, this evidence simply does not support the appellant's assertion that Mr. Humphries "did not look to medical bandages for a solution" (main brief, page 36) to the problem facing the inventor. Moreover, even if this assertion were true, it would

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not belie the clear pertinence of the Bijou reference to the problem facing Hills notwithstanding the actions of Mr. Humphries.

Accordingly, the Bijou reference constitutes analogous prior art which was properly considered by the examiner in evaluating the obviousness of the subject matter set forth in the appellant's claims.

Since the appellant has not otherwise disputed the examiner's proposed combination of the Japanese '381 reference in view of Bijou to reject claim 9, these references are considered to establish a prima facie case of obviousness with respect to the subject matter recited in this claim.

As for the standing 35 U.S.C. § 103 rejection of claims 1 through 16 as being unpatentable over Shimirak in view of the Japanese '381 reference and Bijou, the appellant has not challenged this rejection as it applies to dependent claims 2 through 10 and 13 through 16 with any reasonable specificity. Therefore, claims 2 through 10 and 13 through 16 shall stand or fall with the independent claims from which they respectively depend (see Nielson, 816 F.2d at 1572, 2 USPQ2d at 1528). This leaves for our consideration the merits of the rejection as it applies to independent claims 1, 11 and 12.

Shimirak discloses

a splice between cables 1 and 2 which are multi-wire communication cables each containing 300 pairs of wire conductors. A flexible reservoir, 3, is formed from a plastic film, in this case a nylon film. The reservoir is formed by placing the nylon film around the splice area, 4, and taping the ends of the sheet to the adjacent cable sheath. . . . The reservoir, 3, encompasses the entire splice area, 4, which contains the individual conductors, 7, shown here joined by modular connectors, 8.

. . . The nylon film is positioned and secured to the cable so that a flap, 12, is created. The flap is folded over the opening of the reservoir after it has been filled with liquid sealant. After filling and closing the reservoir, the filled reservoir is compressed, in accordance with this invention, to force the sealant into the splice bundle and adjacent cable core. This can be accomplished by compression wrapping the reservoir by one or more layers of tape.

In the preferred embodiment a first layer of transparent polymeric tape is applied under light pressure. This tape provides a fluid tight seal around the reservoir. Application of the tape with slight compression forces the liquid sealant to penetrate into at least the outer perimeter of the splice bundle and forces any entrapped displaced air to the surface of the liquid sealant. Such entrapped air can be removed by piercing the plastic film and tape to allow the air to escape. An additional wrap of the transparent tape seals any holes so made. In FIG. 3 this first wrap of tape, 13, is over-wrapped with a second layer of tape, 14, which is applied under pressure to compress the sealant-containing reservoir. This second layer of tape is a commercially available tape made of butyl rubber and identified as "Double Rubber" tape. As the tape is applied under pressure it is stretched. Since it is of an elastomeric material, it will continue to exert additional pressure on the compressed reservoir due the elastic recovery forces of the stretched material. Other tapes, such a vinyl tape, can be used

[Shimirak patent, column 4, lines 16 through 64].

Of the compression to be exerted on the reservoir, Shimirak teaches that

[c]ompression of the reservoir exerts pressure on the liquid sealant in the reservoir. It is this pressure which forces the sealant to penetrate into the interstices of the space [sic, splice] bundle and into the adjacent cable. The pressure applied is preferably from about 3 to about 12 pounds per square inch depending on the means used to compress the reservoir. Pressure of up to about 10 pounds per square inch will be adequate for most sealant/reservoir combinations. Of course, the pressure should not be so great as to cause damage to the cable, the cable sheath or any part of the splice [Shimirak patent, column 3, lines 55 through 65].

Shimirak does not disclose a gauge means or elongation indicator of the sort recited in the appealed claims. According to the examiner, however, the combined teachings of Shimirak, the Japanese '381 reference and Bijou would have suggested providing Shimirak's pressure wrap tape with such a gauge means or elongation indicator to delineate the desired amount of stretch of the tape (see pages 7 through 10 in the main answer).

The appellant argues that Bijou is non-analogous art, that there is no suggestion in the prior art to make the combination proposed by the examiner, and that even if the combination were made the resulting tape would not include a stretch indicator which produces a particular appearance when the tape is stretched

a certain amount to yield a desired compressive force (see pages 28 through 36 in the main brief and pages 5 through 7 in the reply brief). None of these lines of argument is persuasive.

For the reasons discussed above, Bijou is analogous prior art which was properly considered by the examiner in evaluating the obviousness of the subject matter set forth in the appellant's claims.

As for the combination proposed by the examiner, Shimirak teaches that the stretched elastomeric tape will apply a pressure or compressive force to the sealant in the reservoir due to its elastic recovery force or resiliency, and that the amount of pressure applied must be adequate to force the sealant to penetrate into the interstices of the splice bundle but not be so great as to cause damage. As noted above, Shimirak states that the pressure "is preferably from about 3 to about 12 pounds per square inch depending on the means used to compress the reservoir" and that "[p]ressure of up to about 10 pounds per square inch will be adequate for most sealant/reservoir combinations." Thus, Shimirak would have conveyed to the artisan the necessity of regulating the amount of stretch in the tape so as to achieve a desired amount of compressive force applied by the tape due to its resiliency.

The Japanese '381 reference and Bijou teach techniques for achieving such an end. As discussed above, the Japanese '381 reference discloses a stretchable cable wrapping tape having a printed gauge means or elongation indicator thereon which presents a first, generally distorted appearance when the tape is unstretched and a second, generally undistorted appearance when the desired stretch quantity and specified tension are achieved. Bijou discloses a stretchable elastic bandage having a printed gauge means or elongation indicator thereon which presents a first appearance when the bandage is unstretched and a second appearance corresponding to the amount of tension in the bandage and the amount of pressure which will be applied thereby when the bandage is stretched. One of ordinary skill in the art would have appreciated the applicability of these disclosures to the problem posed by Shimirak and would have found it obvious in view of such appreciation to provide the Shimirak pressure wrap tape with similar gauge means or elongation indicators to provide a visual indication when the tape is stretched a certain amount to apply the desired compressive force.

Thus, the combined teachings of Shimirak, the Japanese '381 reference and Bijou establish a prima facie case of obviousness with respect to independent claim 11, which requires that the

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elongation indicator present a second, generally undistorted appearance when the tape is stretched a certain amount to yield a desired compressive force, and with respect to claims 1 and 12,

which require that the gauge means present a generally undistorted appearance related to the amount of stretch only.

Turning now to the appellant's evidence of patentability, the teachings of the examiner's applied prior art evidence of obviousness must be considered anew along with such evidence to determine the ultimate question of obviousness. See Oetiker, 977 F.2d at 1446, 24 USPQ2d at 1444-45; Piasecki, 745 F.2d at 1472, 223 USPQ at 788.

All of the appellant's evidence of patentability, which consists of the Hills Objective Evidence Declaration, the supplemental Hills Objective Evidence Declaration, the Hills Technical Declaration and the Wagner declaration, is pertinent to the ultimate question of obviousness. The following characterization by the appellant of the Hills Objective Evidence Declaration also applies to the collective showing of all of the declarations:

The Hills' [sic] Objective Evidence Declaration includes the following types of objective evidence relating to the Hills Invention [i.e., the claimed invention]:

1. Longfelt need for a device and method for applying a desired compression in a cable splice closure system, and evidence that the Hills Invention satisfied that longfelt need;
2. Failure of others to solve the problem of applying a desired compression in a wire splice closure system;
3. Copying of the Hills Invention;
4. Commercial success of the Hills Invention;
5. Praise by experts of the Hills Invention;
6. Commercial acquiescence to the Hills Invention; and
7. Skepticism of experts that a solution to the compression problem could be found [main brief, page 15].

The appellant's arguments relating to this evidence are set forth in detail on pages 15 through 17 and 36 through 40 in the main brief and on pages 7 through 10 in the reply brief.

The appellant's showing relating to commercial success is founded upon the sales figures set forth in Exhibit B of the Hills Objective Evidence Declaration. The explanation in paragraph 6 of the declaration indicates that these figures reflect the sales of all products "encompassed within the claims of the '579 Patent," including those of the appellant's competitors. In short, these sales figures do not constitute persuasive evidence of commercial success.

To begin with, the appellant has failed to submit any

factual basis to substantiate the sales figures. Moreover, even if these figures were accepted at face value, they have not been placed in any meaningful context such as share of a definable market. Bald sales figures such as these show little in relation to commercial success. See Huang, 100 F.3d at 137, 40 USPQ2d at 1689 (Fed. Cir. 1996); Cable Elec. Prods. v. Genmark, Inc., 770 F.2d 1015, 1026-27, 226 USPQ 881, 887-88 (Fed. Cir. 1985).

Furthermore, even if the sales figures in question were sufficient to demonstrate some degree of commercial success, such success is relevant in the obviousness context only if there is proof that the sales were a direct result of the unique characteristics of the claimed invention - as opposed to other economic and commercial factors unrelated to the quality of the patented subject matter. Id. Arguably, the appellant's evidence, taken as a whole, shows that the appellant's own sales were a direct result of the allegedly unique characteristics of the claimed invention, i.e., the characteristics relating to the gauge means or elongation indicator. This showing is of little moment, however, because the evidence (1) does not specify the portions of the sales figures attributable to the appellant and to the competitors, respectively, and (2) does not demonstrate that the competitors' sales were a direct result of the allegedly

unique characteristics of the invention.

The appellant's declarations are also unpersuasive to the extent that they are purported to show a solution to a longfelt need in the art, failure of others to solve the problem, skepticism of experts that a solution to the problem could be found, copying, praise by experts and commercial acquiescence. The problem here is that the appellant's showing in these areas fails to take into account the knowledge in the prior art embodied by the Japanese '381 reference. This reference was in the public domain as of March 29, 1977, well before the occurrence of the various events described in the declarations, and teaches the very gauge means or elongation indicator which is essential to the claimed invention (see EWP Corp. v. Reliance Universal, Inc. v. Reliance Universal, Inc., 755 F.2d 898, 907-08, 225 USPQ 20, 25-26 (Fed. Cir.), cert. denied, 474 U.S. 843 (1985)). The failure of the appellant's declaration evidence to deal with this prior art knowledge renders untenable any contention that it establishes non-obviousness of the claimed invention based on the factors of solution to a longfelt need in the art, failure of others to solve the problem, skepticism of experts that a solution to the problem could be found, copying, praise by experts and commercial acquiescence.

In light of the foregoing, the evidence of obviousness advanced by the examiner in support of the various 35 U.S.C. § 103 rejections on appeal clearly outweighs the evidence of non-obviousness presented by the appellant. Accordingly, we shall sustain the standing 35 U.S.C. § 103 rejection of claim 5 as being unpatentable over the Japanese '381 reference in view of TELTRONICS, INC.'S RESPONSE TO SOUTHWESTERN BELL TELEPHONE COMPANY'S FIRST REQUEST FOR ADMISSIONS, the standing 35 U.S.C. § 103 rejection of claim 9 as being unpatentable over the Japanese '381 reference in view of Bijou, and the standing 35 U.S.C. § 103 rejection of claims 1, 11 and 12, and claims 2 through 10 and 13 through 16 which stand or fall therewith, as being unpatentable over Shimirak in view of the Japanese '381 reference and Bijou.

NEW REJECTIONS ENTERED PURSUANT TO 37 CFR § 1.196(b)

The following rejections are entered pursuant to the provisions of 37 CFR § 1.196(b).

Claims 1 and 6 through 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Bijou.

Bijou, described above, discloses an elastic bandage having indicia imprinted or otherwise applied to the surface thereof at intervals throughout the length of the bandage. The

bandage constitutes a tape<sup>16</sup> which is designed to be longitudinally stretched to apply a compressive force. The indicia presents a generally distorted visual appearance, for example rectangular or ovular, in the unstretched condition and a generally undistorted visual appearance, for example square or circular, when stretched a desired longitudinal amount (see Figures 1 through 5 and column 2, lines 3 through 39). Such tape is inherently capable of functioning as a wrap for compressing a wire or the like. Thus, Bijou meets, either expressly or under principles of inherency, each and every limitation recited in claims 1 and 6 through 8.

As discussed above, most of the appellant's evidence of unpatentability pertains to issues of obviousness and thus is not relevant to the question of anticipation (see Fracalossi, 681 F.2d at 794, 215 USPQ at 571). The portion of such evidence which is pertinent to the issue of anticipation, the Hills

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<sup>16</sup> The word "tape" is defined in Webster's New Collegiate Dictionary (Springfield, MA, G. & C. Merriam Co., 1977) as meaning "a narrow or flexible strip or band," words which describe Bijou's elastic bandage. Words in a claim are generally given their ordinary and accustomed meaning unless it appears that the inventor used them differently. Paulsen, 30 F.3d at 1480, 31 USPQ2d at 1674. There is nothing in the record to indicate that Hills intended the word "tape" as used in the appealed claims to have anything other than its ordinary and accustomed meaning.

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Technical Declaration, does not constitute persuasive evidence that the subject matter recited in claims 1 and 6 through 8 is novel over Bijou because it is not commensurate with the scope of these claims and has little, if any, relevance to Bijou's disclosure. In addition, the arguments in the main and reply briefs that Bijou is non-analogous art are not germane to a rejection under § 102 (see In re Self, 671 F.2d 1344, 1350-51, 213 USPQ 1, 7 (CCPA 1982)).

Claims 1 through 16 are rejected under 35 U.S.C. § 103 as being unpatentable over The Deposition of Gary Hills, dated May 11, 1994, In The Matter Of TELTRONICS, INC., A TX CORP. vs. MINNESOTA MINING AND MANUFACTURING CO., A MN CORP. in view of the Japanese '381 reference.

In the deposition, Gary Hills, the listed inventor in the patent under reexamination, admits that wraps/tapes for compressing a wire or the like and a method of using same to protect a wire, wire splice or the like, meeting all of the limitations in the appealed claims except for those relating to the gauge means (claims 1 through 10 and 12 through 16) or elongation indicator (claim 11), were known in the prior art prior to his invention of the subject matter recited in the appealed claims.

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The Japanese '381 reference, discussed in detail above, would have provided the artisan with ample suggestion to incorporate a gauge means or elongation indicator of the type recited in the appealed claims into the prior art wraps/tapes and method of using same. Given the teachings of the Japanese '381 reference, one of ordinary skill in the art would have appreciated that this modification would facilitate the manual winding of the wraps/tapes at a specified tension and stretch quantity by providing means for visually indicating when the desired tension and stretch quantity are attained. With regard to the particular appearances of the gauge means specified in claims 7 through 10, the Japanese '381 reference expressly teaches the rectangular/square and ovular/circular appearances recited in claims 7 and 8, respectively, and would have suggested the appearances recited in claims 9 and 10, which are not alleged to solve a stated problem or present novel or unexpected results, as an obvious matter of design choice well within the skill of the art (see In re Kuhle, 526 F.2d 553, 554-55, 188 USPQ 7, 8-9 (CCPA 1975)).

Thus, the Hills admissions and the Japanese '381 reference establish a prima facie case of obviousness with respect to the subject matter recited in claims 1 through 16.

As explained above, the appellant's evidence of non-obviousness has little, if any, probative value in terms of showing relevant commercial success, and is relatively weak when viewed in light of the Japanese '381 reference in terms of showing solution to a longfelt need in the art, failure of others to solve the problem, skepticism of experts that a solution to the problem could be found, copying, praise by experts and commercial acquiescence. On the ultimate issue of the obviousness of the subject matter recited in claims 1 through 16, the Hills' admission of prior art and the teachings of the Japanese '381 reference clearly outweigh the appellant's evidence of non-obviousness.

In summary:

a) the decision of the examiner to reject claims 1 through 4, 6 through 8 and 10 through 16 under 35 U.S.C. § 102(b) as being anticipated by the Japanese '381 reference is affirmed with respect to claims 1 through 3, 6 through 8, 10 and 12 through 16, and reversed with respect to claims 4 and 11;

b) the decision of the examiner to reject claims 1 through 4, 6 through 8 and 10 through 16 under 35 U.S.C. § 102(b) as being anticipated by the Japanese '880 reference is affirmed with respect to claims 1 through 3, 6 through 8 and 10 through 16, and

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reversed with respect to claim 4;

c) the decision of the examiner to reject claim 5 under 35 U.S.C. § 103 as being unpatentable over the Japanese '381 reference in view of TELTRONICS, INC.'S RESPONSE TO SOUTHWESTERN BELL TELEPHONE COMPANY'S FIRST REQUEST FOR ADMISSIONS is affirmed;

d) the decision of the examiner to reject claim 9 under 35 U.S.C. § 103 as being unpatentable over the Japanese '381 reference in view of Bijou is affirmed;

e) the decision of the examiner to reject claims 1 through 16 under 35 U.S.C. § 103 as being unpatentable over Shimirak in view of the Japanese '381 reference and Bijou is affirmed; and

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f) new rejections of claims 1 through 16 are entered pursuant to 37 CFR § 1.196(b).

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date hereof. 37 CFR § 1.197.

With respect to the new rejections under 37 CFR § 1.196(b), should appellant elect the alternate option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. In the event appellant elects this alternate option, in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejections, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejections are overcome.

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If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to us for final action on the affirmed rejections, including any timely request for reconsideration thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED; 37 CFR 1.196(b)

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| HARRISON E. McCANDLISH, Senior | ) |                 |
| Administrative Patent Judge    | ) |                 |
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|                                | ) | BOARD OF PATENT |
| CHARLES E. FRANKFORT           | ) |                 |
| Administrative Patent Judge    | ) | APPEALS AND     |
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|                                | ) |                 |
| JOHN P. McQUADE                | ) |                 |
| Administrative Patent Judge    | ) |                 |

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